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10/040,106	10/24/2001	Daniel F. Broderick	CL/V- 31796A	8824

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ONE HEALTH PLAZA 430/2  
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EXAMINER
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STULTZ, JESSICA T

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/040,106

Applicant(s)

BRODERICK ET AL.

Examiner

Jessica T Stultz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 35-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 23, 27 and 30-34 is/are rejected.
- 7) ☒ Claim(s) 18-22, 24-26, and 28-29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed October 7, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the all of the information referred to therein has not been considered.

Specifically, the International Search Report of July 24, 2002, Patent DE 10007705, Patent DE 4224922, and WO 01/32074, were not included in the IDS and therefore were not considered. US 5,893,363, US 6,095,650, and EP 1 011 006 were printed out by the examiner, considered, and have been added to the file.

The information disclosure statement filed October 7, 2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application-by-application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- 1) It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should

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include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

2) It does not identify the citizenship of each inventor.

3) It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

### ***Election/Restrictions***

Applicant's election without traverse of Group I, claims 1-2, and 30-34, in Paper No. 7 is acknowledged. Applicant also amended claims 3, 4, 6, 8-11, 18, 20, and 24, so that Group II could be made readable on the species in Group I. Therefore, claims 3-29 were added into the species of Group I and were examined along with the elected claims 1-2, and 30-34. Applicant has cancelled non-elected 35-71 without prejudice.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17, 23, 27, and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gao et al in view of Streibig.

Regarding claim 1, Gao et al discloses a method of providing customized contact lenses to a user (Column 23, lines 15-24, wherein the method is system "10", shown in Figure 22), the method comprising the steps of: providing a choice of sample eyes for selection by the user as a

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modeling template (Column 23, lines 29-32, wherein the samples are held in database "16"); selecting one or more of said sample eyes as a template eye (Column 23, lines 33-47); selecting one or more colors from a pallet of colors for coloring superposition areas of said selected pattern (Column 23, lines 26-32); and adjusting the colors to generate an image of a contact lens with the user selections (Column 23, lines 58-62); but does not specifically disclose selecting a pre-configured pattern for superposition onto a portion of the template eye and adjusting the pattern as well as the colors to generate an image of a contact lens with the user selections.

Streibig teaches of a system for providing customized contact lens to a user which further comprises selecting a pre-configured pattern for superposition onto a portion of the template eye (Column 3, lines 16-40, wherein the contact lens "20" has a predetermined pattern, Figure 1) and adjusting the pattern for the purpose of generating an image of a contact lens as desired by the user (Column 3, line 41-Column 5, line 52, wherein the two sub-processes are described which form a designated pattern and color combination on a contact lens surface, Figure 3). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the method of providing a customized contact lens of Gao et al further include the steps of selecting a pre-configured pattern for superposition onto a portion of the template eye and adjusting the pattern to generate an image of a contact lens consistent with the user selections since Streibig teaches of a system for providing customized contact lens to a user which comprises selecting a pre-configured pattern for superposition onto a portion of the template eye and adjusting the pattern for the purpose of generating an image of a contact lens as desired by the user.

Regarding claim 2, Gao et al and Streibig disclose and teach of the system disclosed above in claim 1 and Gao et al further discloses a system for providing a contact lens to a user comprising the step of generating contact lens manufacturing parameters and procedures in accordance with the image and the user selections (Column 23, lines 33-62).

Regarding claim 3, Gao et al discloses a method of providing a customized contact lens to a user linked to a computer network interface (Column 23, lines 15-56, Figure 22), said method comprising configuring the customized contact lens for the user linked to a computer network interface (Column 23, lines 15-32, wherein the system "10" is a software package to be used in a computer network and the color samples are housed in a database network "16", Figure 22), wherein the configuring includes the steps of: providing a plurality of sample eye templates for selection by the user via the computer network interface (Column 23, lines 29-32); receiving a request from the user indicating selection of at least one of the eye templates (Column 23, lines 26-32, wherein the color selection is pre-determined by the user); providing the user with a plurality of available colors for incorporation into a portion of the selected template (Column 23, lines 26-32, wherein the available colors are stored in a database "16"); receiving a request from the user indicating selection of at least one the colors (Column 23, lines 26-32, wherein the color selection is pre-determined by the user); but does not specifically disclose providing the user with an image of the selected eye template incorporating the at least on selected color; receiving a request from the user to order at least on contact lens made in accordance with the image an the template; and forwarding information relating to the image for fabrication into at least one contact lens made in accordance with the image and the template. Streibig teaches of a system for providing customized contact lens to a user which further comprises providing the user with

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an image of the selected eye template incorporating the at least one selected color for the purpose of generating an image of a contact lens as desired by the user (Column 3, line 41-Column 5, line 52, wherein the two sub-processes are described which form a designated pattern and color combination on a contact lens surface, Figure 3) and it is well known in the art of ordering products to receive a request from a user to order a contact lens made in accordance with the image and the template; and to forward this information relating to the image for fabrication into at least one contact lens made in accordance with the image and the template. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the system of Gao et al to further include the steps of providing the user with an image of the selected eye template incorporating the at least one selected color; receiving a request from the user to order at least one contact lens made in accordance with the image and the template; and forwarding information relating to the image for fabrication into at least one contact lens made in accordance with the image and the template since Streibig teaches of a system for providing customized contact lens to a user which further comprises providing the user with an image of the selected eye template incorporating the at least one selected color for the purpose of generating an image of a contact lens as desired by the user and it is well known in the art of ordering products to receive a request from a user to order the at least one contact lens made in accordance with the image and the template; and to forward this information relating to the image for fabrication into at least one contact lens made in accordance with the image and the template.

Regarding claim 4, Gao et al and Streibig disclose and teach of the system disclosed above in claim 3 and Gao et al further discloses the step of receiving information from the user relating to cornea shape and size; and initially selecting the eye templates in accordance with the

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user-provided information prior to being provided to the user for selection (Column 23, line 22-Column 24, line 12, wherein the iris and pupil sizes are known and the contacts are derived from this information and the iris and pupil are part of the covering layer over the eye, i.e. the cornea, Figure 22).

Regarding claim 5, Gao et al and Streibig disclose and teach of the system disclosed above in claims 3-4 and Gao et al further discloses forwarding the request to a manufacturing system; and manufacturing a contact lens in accordance with the user selection (Column 23, line 15-Column 24, line 19, wherein the system "10" makes contact lenses with the desired specifications, Figure 22).

Regarding claim 6, Gao et al discloses a method of providing a customized contact lens to a user linked to a computer network interface (Column 23, lines 15-56, Figure 22); said method comprising configuring the customized contact lens for the user linked to a computer network interface (Column 23, lines 15-32, wherein the system "10" is a software package to be used in a computer network and the color samples are housed in a database network "16", Figure 22), wherein the configuring includes the steps of: displaying a template eye image to assist the user in visualizing selected options for a customized contact lens (Column 23, lines 29-32, wherein the samples are held in database "16"); and displaying a plurality of contact lens selection options to the user, the selection options including a plurality of selectable lens colors (Column 23, lines 29-32), but does not specifically disclose sending an order request to order a contact lens and that the selection options include lens design patterns. Streibig teaches of a system for providing customized contact lens to a user which further comprise selecting lens design patterns (Column 3, lines 16-40, wherein the contact lens "20" has a predetermined



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pattern, Figure 1) for the purpose of generating an image of a contact lens as desired by the user (Column 3, line 41-Column 5, line 52, wherein the two sub-processes are described which form a designated pattern and color combination on a contact lens surface, Figure 3) and it would have been obvious to send an order request to order the contact lens since it is well known in the art of ordering products to order a product in this manner. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the method of providing a customized contact lens of Gao et al further include sending an order request to order a contact lens and that the selection options include lens design patterns since Streibig teaches of a system for providing customized contact lens to a user which further comprise selecting lens design patterns for the purpose of generating an image of a contact lens as desired by the user and since it is well known in the art of ordering products to order a product by sending an order request to order the contact lens.

Regarding claim 7, Gao et al and Streibig disclose and teach of the system disclosed above in claim 6 and it would have been obvious that this system comprise the steps of incorporating lens colors and lens design patterns selected by the user into the order request; receiving the order request; and manufacturing a contact lens incorporating the lens colors and lens design patterns selected by the user since it is well known in the art of ordering products for an order request to be processed in this manner for the purpose of customer satisfaction.

Regarding claims 8 and 9, Gao et al and Streibig disclose and teach of the system disclosed above in claims 6 and 7 and Streibig further teaches that a system to configure customized contact lenses comprise the step of deriving a contact lens pattern that, when worn, modifies the appearance of an eye according to the intentions of the user for the purpose of

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enhancing the irises (Column 3, lines 23-40, Figure 1). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the system of Gao et al to further include comprise the step of deriving a contact lens pattern that, when worn, modifies the appearance of an eye according to the intentions of the user since Streibig further teaches that a system to configure customized contact lenses comprise the step of deriving a contact lens pattern that, when worn, modifies the appearance of an eye according to the intentions of the user for the purpose of enhancing the irises.

Regarding claim 10, Gao et al and Streibig disclose and teach of the system disclosed above in claims 6-7 and Gao et al further discloses that the configuring comprise the step of scanning a portion of an eye to create an image for use as the template eye image (Column 23, lines 15-24).

Regarding claim 11, Gao et al and Streibig disclose and teach of the system disclosed above in claim 6 and Streibig further teaches the step of incorporating the lens colors and lens design patterns selected by the user into the template eye image to produce a modified template eye image; and displaying the modified template image to the user for approval and for the purpose of generating an image of a contact lens as desired by the user (Column 3, line 41-Column 5, line 52, wherein the two sub-processes are described which form a designated pattern and color combination on a contact lens surface, Figure 3). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the system of Gao et al to further include the step of incorporating the lens colors and lens design patterns selected by the user into the template eye image to produce a modified template eye image; and displaying the modified template image to the user for approval since Streibig teaches the step of

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incorporating the lens colors and lens design patterns selected by the user into the template eye image to produce a modified template eye image; and displaying the modified template image to the user for approval and for the purpose of generating an image of a contact lens as desired by the user.

Regarding claim 12, Gao et al and Streibig disclose and teach of the system disclosed above in claim 6 and Streibig further teaches that the user be linked to a computer network via a user interface, and that the step of displaying contact lens selection information be performed via the interface for the purpose of quick and easy displays (Column 3, lines 41-57) and it would have been obvious for the step of sending the order request through the interface since it is well known in the art of ordering products for an order request to be sent through an interface. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the system of Gao et al to further include the user being linked to a computer network via a user interface, that the step of displaying contact lens selection information be performed via the interface, and the step of sending the order request be performed through the interface since Streibig further teaches that the user be linked to a computer network via a user interface, and that the step of displaying contact lens selection information be performed via the interface for the purpose of quick and easy displays and since it is well known in the art of ordering products for an order request to be sent through an interface.

Regarding claims 13-15, Gao et al and Streibig disclose and teach of the system disclosed above in claim 12, and it would have been obvious for the interface to be a personal computer having a visual display, a handheld personal computing device, or a portable laptop computer,

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since it is well known in the art of computer systems to use any of the above systems as an interface.

Regarding claims 16-17, Gao et al and Streibig disclose and teach of the system disclosed above in claim 6, and Streibig further teaches the step of providing an image of a contact lens to the user incorporating the selected lens colors and lens design patterns for review by the user (Column 3, lines 41-57) and that the contact lens selection options further comprise lens vision correction parameters for the purpose of correcting the users vision (Column 3, lines 22-23). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the system of Gao et al to further include the step of providing an image of a contact lens to the user incorporating the selected lens colors and lens design patterns for review by the user and that the contact lens selection options further comprise lens vision correction parameters since Streibig further teaches the step of providing an image of a contact lens to the user incorporating the selected lens colors and lens design patterns for review by the user and that the contact lens selection options further comprise lens vision correction parameters for the purpose of correcting the users vision.

Regarding claim 23, Gao et al and Streibig disclose and teach of the system disclosed above in claim 6, and Gao et al further discloses forwarding the request to a manufacturing system; and manufacturing a contact lens in accordance with the user selection (Column 23, line 15-Column 24, line 19, wherein the system "10" makes contact lenses with the desired specifications, Figure 22).

Regarding claim 27, Gao et al and Streibig disclose and teach of the system disclosed above in claim 6, it is inherent that the customized contact lens could be configured for use by a

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person other than the user, this being reasonably based upon the fact that the doctor could order the lens for the patient if they know the specifications desired by the patient.

Regarding claim 30, Gao et al discloses a method of providing a customized contact lens to a user, the method comprising the steps of: displaying a template eye (Column 23, lines 29-32); but does not specifically disclose allowing the user to modify the appearance of the eye, and deriving a contact lens pattern that, when worn, modifies the appearance of an eye according to the intentions of the user. Streibig further teaches that a system to configure customized contact lenses comprise the step of allowing the user to modify the appearance of the eye; and deriving a contact lens pattern that, when worn, modifies the appearance of an eye according to the intentions of the user for the purpose of enhancing the irises (Column 3, lines 23-40, Figure 1). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the system of Gao et al to further include comprise the step allowing the user to modify the appearance of the eye, and deriving a contact lens pattern that, when worn, modifies the appearance of an eye according to the intentions of the user since Streibig further teaches that a system to configure customized contact lenses comprise the step of allowing the user to modify the appearance of the eye, and deriving a contact lens pattern that, when worn, modifies the appearance of an eye according to the intentions of the user for the purpose of enhancing the irises.

Regarding claims 31-32, Gao et al and Streibig disclose and teach of the system disclosed above in claim 30, and it would have been obvious for this system to further comprise the step of modifying the template eye using a handheld device and by selecting a color and a drawing tool,

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since it is well known in the art of colored contacts to modify the template eye in either of this manner.

Regarding claims 33-34, Gao et al and Streibig disclose and teach of the system disclosed above in claim 30, and it would have been obvious for this system to further comprise the step of transmitting the contact lens pattern to at least one entity selected from the group comprising a peer, a lens ordering service or a manufacturer and the step of ordering a contact lens since it is well known in the art ordering products to transmit the information and order the lens in this manner.

***Allowable Subject Matter***

Claims 18-22, 24-26, and 28-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: none of the prior art alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103.

Specifically regarding claims 18-19 none of the prior art alone or in combination disclose or teach of a method for making customized contact lenses specifically comprising the steps of requesting submission of graphic design images from the user.

Specifically regarding claims 20-22 none of the prior art alone or in combination disclose or teach of a method for making customized contact lenses specifically comprising the steps of adjusting the image into a template image to optimize the selected information from the user.

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Specifically regarding claims 24-26 none of the prior art alone or in combination disclose or teach of a method for making customized contact lenses specifically comprising the step of obtaining prescription information from the user.

Specifically regarding claims 28-29 none of the prior art alone or in combination disclose or teach of the a method for making customized contact lenses specifically comprising the step of creating a user profile for the user, which incorporates the prescription information for the user.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Harris and Jahnke are cited as being some similar structure to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T Stultz whose telephone number is (703) 305-6106. The examiner can normally be reached on M-Th 7:30-5, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 703-308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Application/Control Number: 10/040,106

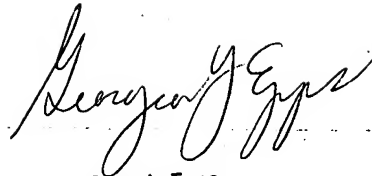
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Jessica Stultz

June 16, 2003



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